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OFFICE OF PETITIONS

In re Application of
Carol Buck
Application No. 10/728,546
Filed: December 5, 2003
Attorney Docket No. 3607-106.4 US

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DECISION ON PETITION

This is in response to the "PETITION TO REINSTATE FILING DATE," filed February 13, 2004, which in essence, requests that the above-identified application be accorded a filing date without drawings present in the application.

Application papers in the above-identified application were filed on December 5, 2003. However, on January 26, 2004, the Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application," stating that the application had not been accorded a filing date because the application was deposited without drawings. This Notice set a two-month period for reply.

In response, applicant timely filed the instant petition, asserting that:

Drawings are not necessary for understanding of the subject matter sought to be patented. The references to drawings in the above-identified application are related to embodiments of the invention previously patented in U.S. Patent No. 6,517,822 and are not related to the invention defined by the present claims.

The petition included the required petition fee of \$130 pursuant to § 1.17(h). Accompanying the petition was a preliminary amendment cancelling references to drawings in the application.

35 U.S.C. 111(a)(4) provides that:

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

However, it is the practice of the Office to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). MPEP §601.01(f)¹.

A review of the original application papers filed December 5, 2003, reveals that they included a specification and at least one method claim. Thus, this application should have been treated as one which does not require drawings. Furthermore, petitioner confirms that drawings are not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). It is concluded that the instant application is entitled to a filing date of December 5, 2003.

Accordingly, the petition is granted to the extent that the application will be accorded the December 5, 2003 filing date with no drawings as a part of the original disclosure of the application.

However, in regards to withdrawing the Notice and refunding the petition fee, MPEP § 601.01(f) also states that:

...a nonprovisional application having at least some disclosure, directed to subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

And, MPEP § 601.01(g) further provides that:

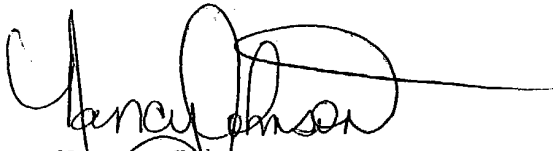
If the application is filed without all of the drawing figure(s) referred to in the specification, ..., OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of the drawings described in the specification.

As the specification contained references to drawing figures, mailing of a Notice requiring submission of those drawings was appropriate. The Office should have mailed a "Notice of Omitted Items" rather than a "Notice of Incomplete Nonprovisional Application." Nonetheless, the filing of a petition was necessary due to the condition of the application on filing. Accordingly, the petition fee is required and will not be refunded.

¹ Petitioner is advised that in a situation in which the appropriate examining group later determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the PTO.

This application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of December 5, 2003 and for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing.

Telephone inquiries specific to this decision may be directed to the undersigned at (703) 305-0309.



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